

Exhibit 8

1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE DISTRICT OF UTAH, CENTRAL DIVISION

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5 DIVERSI-PLAST PRODUCTS, INC.,
a Minnesota corporation,

6

Plaintiff,

7

vs. Civil Action No:
2:04-CV-01005 PGC

8

BATTENS PLUS, INC., a Judge: Paul G. Cassell
9 California corporation,

10 Defendant.

11 _____/

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13

Thursday, January 19, 2006

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VIDEOTAPED DEPOSITION OF
17 MARK JACOBS, ESQ.

18

19 ---oOo---

20 Ref. No. B978

Reported by: John P. Squires, CSR No. 2001

21 Certified Merit Reporter

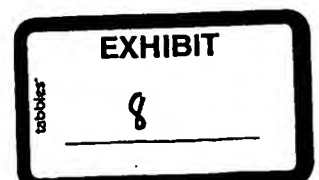
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13 Also present:

14 Richard Cable, Videographer

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1	INDEX	
2	EXAMINATION BY COUNSEL	
3	Page No.	
4	Examination by Mr. Macari	10
5	Examination by Mr. Ballard	91
6	Examination by Mr. Macari	96
7	Examination by Mr. Ballard	99
8	Examination by Mr. Macari	100

9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

1	EXHIBITS	
2	1 Subpoena	11
3	2 Fax from Jacobs to Biasco	20
4	3 Fax from Ted to Mark	24
5	4 Jacobs billing	28
6	5 Letter from Ballard to Jacobs	45
7	6 Battens Plus Responses to Interrogatories	46
8	7 Letter from Jacobs to Anderson	49
9	8 Letter from Anderson to Jacobs	86
10	9 Memorandum from MCJ	92

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11:07:21 1 opinion of counsel with respect --

11:07:22 2 A. I have no opinion.

11:07:23 3 Q. You've never heard of that or seen it, heard

11:07:26 4 it before?

11:07:26 5 A. That is correct.

11:07:34 6 Q. Okay.

11:07:34 7 (Exhibit 7 marked)

11:07:36 8 MR. MACARI: Q. I'm going to hand you --

11:07:36 9 THE WITNESS: Are we done with this?

11:07:38 10 MR. MACARI: Yeah. You can put that down for

11:07:40 11 now, yes.

11:07:50 12 MR. BALLARD: Do you have an extra copy for

11:07:51 13 me?

11:07:52 14 MR. MACARI: Oh, I didn't give it to you, did

11:07:54 15 I? I'm sorry. This is yours.

11:07:56 16 Q. I'm going to hand you what has been marked

11:08:01 17 Exhibit 7.

11:08:10 18 Could you review that document, please.

11:08:12 19 A. I'm familiar with it.

11:08:13 20 Q. I think earlier you spoke of an opinion. Is

11:08:17 21 this the letter you were speaking of?

11:08:18 22 A. Yes.

11:08:19 23 Q. And this is the letter that is addressed to

11:08:22 24 Ted Anderson --

11:08:24 25 A. Correct.

11:08:24 1 Q. -- in Cameron Park, California?

11:08:27 2 A. Right.

11:08:27 3 Q. Again the date at the top of the letter is

11:08:30 4 "November 18, 2003"; is that right?

11:08:32 5 A. Correct.

11:08:33 6 Q. So this letter was sent to you -- I'm

11:08:35 7 sorry -- sent to Mr. Anderson -- I should say sent to

11:08:39 8 Battens Plus care of Mr. Anderson. Is that correct?

11:08:42 9 A. I don't remember what the address situation

11:08:43 10 was. I can't tell you.

11:08:45 11 Q. But you indicated that your client was

11:08:47 12 Battens Plus --

11:08:48 13 A. Correct.

11:08:49 14 Q. But you sent this to Ted Anderson I'm

11:08:52 15 assuming because he was your primary contact there.

11:08:54 16 A. That is correct. That's a safe statement.

11:08:56 17 Q. And this is the same day that you received a

11:08:59 18 fax from Ted Anderson with the letter from

11:09:03 19 Mr. Patterson; correct?

11:09:03 20 A. I have to look. If you say so.

11:09:05 21 Q. Please do. It's Exhibit -- I'm sorry.

11:09:08 22 Exhibit 3, I believe.

11:09:11 23 A. Yeah, I got it right here.

11:09:17 24 Yeah, it appears to be that way.

11:09:19 25 Q. The same day?

11:09:20 1 A. Yes.

11:09:23 2 Q. Okay. And I believe you testified earlier

11:09:27 3 that you don't recall whether or not you had talked to

11:09:29 4 Mr. Anderson prior to receiving his fax. Correct?

11:09:32 5 A. That is correct.

11:09:32 6 Q. Do you recall talking to him sometime on that

11:09:35 7 day with regard to the 193 patent?

11:09:38 8 A. No recollection.

11:09:39 9 Q. Okay. If you could also look at the billing

11:09:45 10 statement that you produced that's marked as Exhibit 4.

11:09:54 11 Somehow my documents are disappearing here.

11:10:02 12 A. Okay. Okay. I guess I did.

11:10:09 13 Q. Okay. So you see the billing record --

11:10:13 14 A. Yes.

11:10:13 15 Q. -- for that day.

11:10:15 16 Could you please look over that. Take your

11:10:18 17 time.

11:10:18 18 A. I see it. I'm fine.

11:10:20 19 Q. All right. You'll see that there are three

11:10:22 20 entries. Correct?

11:10:23 21 A. Correct.

11:10:23 22 Q. Are these the only time entries that you have

11:10:26 23 for the -- well, first of all let's go to the top and

11:10:32 24 figure out what these billing records relate to. At the

11:10:34 25 top it says regarding and then it says "Potential

11:10:37 1 Infringement."

11:10:38 2 A. Right.

11:10:38 3 Q. Do you see that?

11:10:39 4 And file number ANDTED.

11:10:41 5 A. Yes, last name three letters, first name

11:10:45 6 three letters.

11:10:45 7 Q. Is that your normal file system?

11:10:47 8 A. Yes.

11:10:47 9 Q. And so you had opened up a file with regard

11:10:50 10 to this potential infringement issue; correct?

11:10:53 11 A. Correct.

11:10:54 12 Q. Were there any other files relating to this

11:10:57 13 infringement issue?

11:10:58 14 A. No.

11:10:59 15 Q. Do you know if -- did you look through other

11:11:01 16 files when you produced documents for today's

11:11:04 17 deposition?

11:11:04 18 A. Sure. Patent file, which I'm not allowed to

11:11:08 19 talk about, as we both know.

11:11:09 20 Q. I know. And I don't want to know what you

11:11:12 21 found unless it's relating to the infringement --

11:11:14 22 A. No. There was only one.

11:11:15 23 Q. Okay. So you didn't find anything else that

11:11:17 24 was related to your subpoena --

11:11:19 25 A. No, no.

11:29:59 1 Q. And that's because you believed at that time

11:30:01 2 that the Battens Plus product was infringing or covered

11:30:06 3 by the 193 patent?

11:30:09 4 A. Okay. The answer to your question is very

11:30:13 5 specific -- requires very specific language and that is

11:30:17 6 when one considers infringement, one simultaneously

11:30:22 7 considers the issue of validity, and the question was,

11:30:26 8 okay, the patent may be valid, it may be invalid, and I

11:30:30 9 have never got to do and I didn't even -- that far. You

11:30:33 10 see I only spent, you know, like a third of an hour on

11:30:36 11 the letter. It was a quick and dirty request for

11:30:38 12 information, as opposed to, quote, a legal opinion where

11:30:42 13 you're going to get paid a lot of money and a lot of

11:30:46 14 thought and check a file history like any reasonable

11:30:48 15 patent lawyer would do.

11:30:50 16 Q. Okay.

11:30:50 17 A. And I assume both of you gentlemen are

11:30:54 18 reasonable patent lawyers.

11:30:56 19 Q. We hope so.

11:30:57 20 A. Right.

11:30:58 21 Okay. So basically, you know, for a quick

11:31:00 22 and dirty situation it's hey, you got a problem, baby.

11:31:04 23 Okay. And that's basically all I could say.

11:31:08 24 Now, whether the problem can go away -- and

11:31:10 25 that's where Anderson had talked to me about a testing

11:31:13 1 program as I wrote and talked to Patterson and agreed

11:31:16 2 with Patterson we would determine whether the patent was

11:31:20 3 invalid. If the patent is invalid, you can't infringe

11:31:24 4 an invalid patent.

11:31:25 5 So I took no opinion per se. I just say, you

11:31:28 6 got a problem.

11:31:29 7 Q. So at this time, putting aside whether or not

11:31:33 8 you were doing further testing on the issue of validity,

11:31:36 9 at that point you felt that the claims covered the

11:31:39 10 product, assuming it was a valid patent?

11:31:43 11 A. I don't really want to say that.

11:31:45 12 I would rephrase it and say that the unit

11:31:49 13 that was shown to me was covered or was read upon by

11:31:55 14 Claim 1. That is a statement that I can live with.

11:31:59 15 Q. Let's go after some other claims here and

11:32:02 16 talk about them a little bit.

11:32:05 17 Further down in that sentence -- it looks

11:32:07 18 like it's a separate sentence in that paragraph -- it

11:32:08 19 says "The article claim and method claim of 14."

11:32:11 20 A. Yes.

11:32:11 21 Q. What are you referring to there, "the article

11:32:13 22 claim"?

11:32:14 23 A. Well, the way they put it on, the article

11:32:16 24 claim is Claim 1, and the method is -- Claim 14 talks

11:32:19 25 about how you put down a system, do a roof, basically.

11:32:25 1 Q. To a roof?

11:32:28 2 A. Do. D-o.

11:32:29 3 It's my eastern accent.

11:32:31 4 Q. Oh, okay.

11:32:32 5 And so your opinion at that point was that --

11:32:34 6 or your advice is that there was a problem with respect

11:32:36 7 to Claim 1 and Claim 14?

11:32:38 8 A. Correct.

11:32:38 9 Q. Okay. And again it was based on the fact

11:32:41 10 that you believed that the structure of the batten was

11:32:46 11 covered in those claims?

11:32:49 12 A. Yes. I know you're not trying to lead me.

11:32:53 13 And I think that's a fair statement.

11:32:54 14 Q. When I say "the structure of the batten," I

11:32:57 15 want to be correct. I'm talking about the structure of

11:33:00 16 the BattenUP or the Battens Plus batten.

11:33:01 17 A. No. I understand.

11:33:03 18 Q. Okay. All right. And again here you'll see

11:33:04 19 in that paragraph, if you could look at that, it says

11:33:07 20 "Our product as made, read on the 'comprising' language

11:33:14 21 of Claim 1."

11:33:15 22 A. Correct.

11:33:16 23 Q. And again that's the same terminology you

11:33:20 24 used before, in quotes, reads (sic) on?

11:33:21 25 A. Yes.

11:33:22 1 Q. And your understanding of that phrase, "read
11:33:24 2 on," is what?

11:33:25 3 A. The elements of the claim are found in the
11:33:29 4 product.

11:33:30 5 Q. Okay. Had you looked at any other of the
11:33:44 6 other claims besides Claims 1 and 14?

11:33:46 7 A. No recollection.

11:33:47 8 Q. Okay. If you had, would you have referenced
11:33:50 9 it in your letter do you believe?

11:33:51 10 A. Might have.

11:33:52 11 Q. Okay. If you could look at the claims of the
11:33:57 12 193 patent.

11:33:58 13 A. Okay.

11:33:58 14 Q. Do you have it there?

11:33:59 15 A. I have it right here.

11:34:00 16 Q. I'll note for the record that I assume that
11:34:04 17 the deponent is looking at the same version of the
11:34:06 18 claims that I am, but I can't --

11:34:08 19 A. No. I'm looking at the bigger-print version.
11:34:12 20 The issued patent.

11:34:13 21 Q. He's looking at a document other than the
11:34:16 22 exhibit.

11:34:16 23 And just for this purpose right now, I prefer
11:34:19 24 if I could have you look at the actual exhibit --

11:34:19 25 A. Sure.